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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/310,800	05/12/99	CHAUG	Y 96-017-TAX

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WM01/0521

EXAMINER

TUPPER, R

ART UNIT

PAPER NUMBER

2652

21

DATE MAILED:

05/21/01

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UNITED STATES DEPARTMENT OF COMMERCE  
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**MAILED**  
**MAY 21 2001**  
**Technology Center 2600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 21

Application Number: 09/310800  
Filing Date: 5/12/99  
Appellant(s): Chaug et al

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Wayne P. Bailey  
For Appellant

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed 3/8/01.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

Art Unit: 2754

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 3-6, 8-10, and 19-29 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit: 2754

5,022,140

Tsutaki et al

6-1991

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-6, 8-10, and 19-29 are rejected under 35 U.S.C. 102(b) as being anticipated by TSUTAKI et al. This rejection is set forth in prior Office action, Paper No. 16 .

**(11) Response to Argument**

Applicant argues that TSUTAKI et al does not teach “a multi-recording element head assembly”; that the structure relied upon is an “intermediate (i.e. not completed or operational) magnetic core structure that is not operable for either reading or writing”.

Applicant argues that it is only after the magnetic core is cut into a number of single head elements that it is operable to read and write.

The Examiner does not agree. All of the independent claims utilize the term “operable”. This is a statement of intended usage.

The figures cited in TSUTAKI et al show all of the **structural** features listed in these claims - i.e. a substrate and c-shaped closure separated by a gap with a plurality of thin film recording elements on the substrate and a plurality of gluing vias interspersed among the recording elements (note that many of the claims do not even recite this many elements).

The Examiner agrees that TSUTAKI et al does disclose that the structure shown in figures 2 and 3 is ultimately cut as shown by the dotted lines as shown in figure 4G. However, this does not render the rejection defective.

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The structure shown in figure 3E is operable to record/reproduce multiple tracks. Applicants assertion that "adjoining structures would short one another out" is in error. The structure shown in figure 3E shows every **structural** feature listed in applicant's claims.

Concerning claim group II, Applicant further refers to the method recitations in some of the claims and argues that the exact process used defines over TSUTAKI et al. The Examiner does not agree. It is well established that a "product by process" claim is directed to the product per se, no matter how actually made. The patentability of the final product in a "product by process" claim must be determined by the product itself and not that actual process. The weight given to the "product by process" limitation is the structure "gleaned from the process, see *In re Thorpe*, 227 USPQ 964 (CAFC, 11/21/85).

Concerning claim group III, Applicant also argues that TSUTAKI et al does not teach providing gluing vias on only one surface. This is in error. Note claim 7 of TSUTAKI et al recites that the pair of grooves defining each track width (the gluing vias) can be provided on only one of the core halves.

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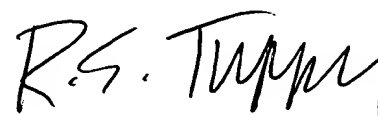
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
conferee: B. Miller

  
SPE: H. Nguyen 5/18/01



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RST  
May 19, 2001

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